APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,244	01/29/2001	Rajkishore Barik	JP920000376US1	9198

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EXAMINER
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ART UNIT	PAPER NUMBER
3622	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	09/772,244	BARIK ET AL.
	Examiner	Art Unit	
	Jeffrey D. Carlson	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *8/9/07, 12/12/07*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5,7,15-19,21-31,33-35,49-57,59-62,64-67,69 and 70* is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5,7,15-19,21-31,33-35,49-57,59-62,64-67,69 and 70* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All   b)☐ Some *   c)☐ None of:

       1.☐ Certified copies of the priority documents have been received.

       2.☐ Certified copies of the priority documents have been received in Application No. _____ .

       3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ .

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application
6)☐ Other: _____ .

DETAILED ACTION

Claim Objections

1.   Claim 65 is objected to under 37 CFR 1.75(c), as being of improper dependent

form for failing to further limit the subject matter of a previous claim. Applicant is

required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper

dependent form, or rewrite the claim(s) in independent form.

- ■   Claim 65 does not further limit the structure of the system/apparatus, but

    rather states where such system apparatus is located. The location of an

    article does not serve to define the structure of the article. Appropriate

    correction is required.

Claim Rejections - 35 USC § 112

2.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

3.   Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite

for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention.

- ■   Claim 21 is an apparatus/program on a medium claim, yet the medium's

    programming makes no particular use of the network whatsoever. It is

    unclear in what manner the claimed medium's programming is further limited

    by what is presented in claim 21.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

5.   **Claims 1-5, 7, 15-19, 21-31, 33, 35, 49-57, 59, 61, 62, 65, 66 are rejected**

under 35 U.S.C. 103(a) as being unpatentable over Fajkowski (US6932270).

6.   Regarding claims 1-3, 15-17, 27, 30, 54, 57, Fajkowski teaches systems and

methods for storing electronic coupons, associating them with customers, presenting

them at a retail POS and redeeming them. A user is provided with a card which

provides a userID [4:6-8]. The card is used to associate selected coupons from a

plurality of available coupons from different sources (by scanning paper coupons, by

selecting coupons at a kiosk or by downloading coupons from the Internet) with the

user's account in a database [3:63-65, 6:I-5,6:22-25]. When the card is presented at the

POS along with products to be purchased, the POS system determines what coupons

of the user's collection of selected coupons are redeemable given the user's potential

purchases; the system displays these coupons on the display [16:18-31, 17:31-33,4:25-

35]. Fajkowski teaches that the coupon eligibility parameters (product name, required

size, quantity or combination of items required, expiration) may be stored on the card in

order to determine applicable coupons at the POS [10:17-26]. Applicant admits that

mutual exclusivity is a restrictive, eligibility coupon parameter often used [spec page 1

lines 21-22]. It would have been obvious for one of ordinary skill in the art at the time of

the invention to have stored and analyzed other well known coupon restriction rules

such as whether other coupons can be used in combination with a coupon. Doing so

would enable the system to process and accurately display a wide variety of eligible

coupons, including those with exclusivity rules. Examiner will now address the

limitations associated with checking if eligible coupons also meet optimization

parameters. Applicant has admitted that customers frequently have a collection of

eligible coupons from which to choose, leaving the consumer with the task of

determining which subset of eligible coupons to use. It has been done manually, but it is

admittedly difficult in certain situations [spec pg 2 lines 11 -19]. Historically checkout

clerks inherently were required to possess the ability to determine coupon eligibility,

else fraudulent coupon redemption would be possible. One of ordinary skill would

consider it to be a matter of good customer service for a checkout clerk to assist a

customer regarding which coupons could be used (i.e. eligibility) as well which subset of

coupons would most benefit the customer for example helping a customer who asks

"which coupon(s) would' save the most money?" and/or "which of these coupons should

I use quickly before they expire" There should be no doubt that consumers frequently

use coupons in order to get the best savings. It would have been obvious to one of

ordinary skill at the time of the invention to have provided assistance to customers faced

with navigating the recognized (albeit in some cases difficult or confusing) coupon rules

and options imposed by the retailer. Fajkowski's system accomplishes the automated

eligibility determination in the manner of an Expert System (a computer system

programmed to replace a human clerk having the knowledge to determine eligibility for

the universe of participating coupons and their restrictions/parameters). Fajkowski's

system is also quite intelligent in that it can recommend an additional purchase when a

consumer possesses a valuable coupon, but has not fully met the purchasing

qualifications (perhaps the user chose the wrong size product) [19:38-431. This is

another example of an Expert System capability. Fajkowski's system has been argued

to lack presentation to the consumer of a subset of all eligible coupons according to

price optimization, yet it would have been obvious to one of ordinary skill at the time of

the invention to have provided this desired but heretofore manual capability in an

automated manner. See Automating a manual activity -MPEP 2144.04(111). In re

Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958).

Regarding claims 4, 18, Fajkowski teaches that coupons could be displayed

which are not fully eligible along with the reasoning for their near-eligible status, such as

the product is the wrong size [I9:38-431. It would have been obvious for one of ordinary

skill in the art at the time of the invention to have displayed a similar message when a

user has not presented the proper quantity or combination of products [these

parameters are disclosed at 10:22-231 when possessing a coupon with such size or

quantity restrictions. Both of these examples are taken to provide a teaching of

recommending the missing product to the customer for more discounts.

Regarding claims 5, 19, 35, 61, 65, 66, Fajkowski teaches that the coupons may

at least be stored at a third party site (Internet) or kiosk (retailer site). The system is

taken to reside at the retailer site.

Regarding claims 7, 21, the network is described as the Internet.

Regarding claims 22, 23, 49, 50, 62, Fajkowski's determination of coupons specific to products presented is taken to provide a step of computing a set of coupons dependant upon a user's set of coupons as well as upon the order information. The step of determining if the computed coupon set complies with redeeming conditions is met by inspecting the other various criteria such as expiration, etc.

Regarding claim 24, 51, if in Fajkowski a customer provides a coupon that does not comply with redemption criteria, the customer is free to return another time with a another set of coupons.

Regarding claims 25, 26, 52, 53, Fajkowski teaches that while compliant coupons are shown at the POS, the customer may wish to investigate why some coupons were non-complaint [I9:21-251. The POS may be used to display all coupons that were non-compliant [19:44-531; it would have been obvious for one of ordinary skill in the art at the time of the invention to have displayed non-compliant coupons for any non-compliant criteria including the suggested mutually exclusive criteria above.

Regarding claims 28, 29, 55, 56, Fajkowski teaches that the user may save shopping lists with specified coupons for the products on the list to be used on future shopping trips. Fajkowski also teaches the idea of issuing a rain check for a coupon item the user wishes to purchase, but where the item is currently unavailable. The system will save such a list of rain-checked product(s) for later use. In either case, future use of the saved lists are taken to meet the broad "comparing" by a user.

Regarding claim 31, Fajkowski teaches that a user may be provided with reports of coupon usage and savings [I 3:5-7, 17:48-63]. User acceptance for redemption of the displayed eligible coupons provides a viewing of reports of coupon usage.

Regarding claim 33, 59, the system is taken to inherently use an AND condition for a coupon having plural redemption conditions (expiration date and product size, for example).

Claims 3, 10, 17 (alternatively) and 34, 47, 60, 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fajkowski in view of Beach et al (US200210107738).

Beach et al also teaches user collection of e-coupons which are redeemed at the POS [para. 13]. Beach et al teaches that coupons can be recommended to the user based on his user profile [para. 35 (middle of page)]. It would have been obvious for one of ordinary skill in the art at the time of the invention to have suggested coupons for the user based on his profile so that the user can be conveniently targeted with offers that are likely to be accepted and purchased. These recommendations are taken to be optimal or near optimal recommendations.

Claims 1-5, 7, 15-19, 21-31, 33, 35, 49-57, 59, 61-62, 65, 66 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Fajkowski (US6932270) in view of Marmon (1184446528).

Regarding claims 1-3, 15-17, 27, 30, 54, 57, Fajkowski teaches systems and

methods for storing electronic coupons, associating them with customers, presenting

them at a retail POS and redeeming them. A user is provided with a card which

provides a ,userID [4:6-81. The card is used to associate selected coupons from a

plurality of available coupons from 'different sources (by scanning paper coupons, by

selecting coupons at a kiosk or by downloading coupons from the Internet) with the

user's account in a database [3:63-65, 6:1-5, 6:22-251. When the card is presented at

the POS along with products to be purchased, the POS system determines what

coupons of the user's collection of selected coupons are redeemable given the user's

potential purchases; the system displays these coupons on the display [I6:18-31, 17:31-

33,4:25-351. Fajkowski teaches that the coupon eligibility parameters (product name,

required size, quantity or combination of items required, expiration) may be stored on

the card in order to determine applicable coupons at the POS [I 0:17-261. Applicant

admits that mutual exclusivity is a restrictive, eligibility coupon parameter often used

[spec page 1 lines 21-22]. It would have been obvious for one of ordinary skill in the art

at the time of the invention to have stored and analyzed other well known coupon

restriction rules such as whether other coupons can be used in combination with a

coupon. Doing so would enable the system to process and accurately display a wide

variety of eligible coupons, including those with exclusivity rules. Examiner will now

address the limitations associated with checking if eligible coupons also meet

optimization parameters. Applicant has admitted that customers frequently have a

collection of eligible coupons from which to choose, leaving the consumer with the task

of determining which subset of eligible coupons to use. It has been done manually, but it is admittedly difficult in certain situations [spec pg 2 lines 11-19]. Historically checkout clerks inherently were required to possess the ability to determine coupon eligibility, else fraudulent coupon redemption would be possible. Marmon teaches that shopping can get quite complicated when pricing systems are combined with cents off coupons and retailers offer to double or triple coupons [col 1 lines 38-42]. Fajkowski provides a calculating tool for optimizing purchasing decisions affected by the complex pricing combinations that include coupons [col 1 lines 50-601. Marmon notes that the consumer is confronted with many price-affecting choices related to coupons and that he usually is seeking low prices [col 2 lines 53-57]. Understanding the choice of optimum purchase requires and understanding of coupon procedures (i.e. rules) and unit pricing techniques [col 3 lines 20-221. The calculations done by the system of Fajkowski consider the impact of the coupon and the optimum choice, i.e. lowest until price is indicated to the user [col 3 lines 51-53]. Fajkowski's system accomplishes the automated eligibility determination and it would have been obvious to one of ordinary skill at the time of the invention to have also provided automated coupon optimization assistance (i.e. indicating the best coupon(s) to use in order to best reduce the price given the subset of eligible coupons possessed) to customers faced with navigating the coupon rules and options imposed by the retailer. This would .enable the customer to most benefit from his coupons, delivery the lowest prices as is generally desired as well as encourage purchasing of retailer products.

Regarding claims 4, 18, Fajkowski teaches that coupons could be displayed which are not fully eligible along with the reasoning for their near-eligible status, such as the product is the wrong size [19:38-43]. It would have been obvious for one of ordinary skill in the art at the time of the invention to have displayed a similar message when a user has not presented the proper quantity or combination of products [these parameters are disclosed at 10:22-23] when possessing a coupon with such size or quantity restrictions. Both of these examples are taken to provide a teaching of recommending the missing product to the customer for more discounts.

Regarding claims 5, 19, 35, 61, 65, 66, Fajkowski teaches that the coupons may at least be stored at a third party site (Internet) or kiosk (retailer site). The system is taken to reside at the retailer site.

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non-complaint [19:21-251. The POS may be used to display all coupons that were non-compliant [19:44-531; it would have been obvious for one of ordinary skill in the art at the time of the invention to have displayed non-compliant coupons for any non-compliant criteria including the suggested mutually exclusive criteria above.

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Regarding claim 31, Fajkowski teaches that a user may be provided with reports of coupon usage and savings [13:5-7, 17:48-631. User acceptance for redemption of the displayed eligible coupons provides a viewing of reports of coupon usage.

Regarding claim 33, 59, the system is taken to inherently use an AND condition for a coupon having plural redemption conditions (expiration date and product size, for example).

Claims 3, 17, 34, 60, 64 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Fajkowski in view of Beach et al (US200210107738).

Beach et al also teaches user collection of e-coupons which are redeemed at the POS [para. 131. Beach et al teaches that coupons can be recommended to the user based on his user profile [para. 35 (middle of page)]. It would have been obvious for one

of ordinary skill in the art at the time of the invention to have suggested coupons for the user based on his profile so that the user can be conveniently targeted with offers that are likely to be accepted and purchased. These recommendations are taken to be optimal or near optimal recommendations.

Response to Arguments

Applicant argues that the art does not teach a user defining optimization parameters and display of eligible coupons satisfying the criteria. The rejection above addresses the concept that one of ordinary skill would find it obvious that rather than choose the best coupons manually (as admitted has happened in the past), to automate the recognized difficult, and/or time consuming tasks of choosing the best coupon for that user's desires. One of ordinary skill would see that a computer programmed with the coupon rules/restrictions would be a predictably faster, more convenient, and more accurate way to navigate the same steps historically done manually. Further, *KSR* forecloses the argument that a specific teaching is required for a finding of obviousness (citing *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396). See Board decision *Ex parte Smith*, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007).

It was well known at the time of the invention that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). For example, simply automating the steps of coupon selection gives just what one would expect from the otherwise manual steps. In other words, there is no

enhancement found in the claimed steps/system other than the known advantage of

increased speed, increased accuracy, increased convenience and reduction in human

resource(s) to perform/provide the claimed steps/functionality. The end result is the

same as compared to the manual method.

Conclusion

The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure:

- Aggarwal et al (7013286) teaches electronic coupon redemption and a

  system that determines eligible coupons as well as helps the customer decide

  what coupon(s) to use if the customer reveals what coupons he has [col 12

  lines 44-50].

7.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-

6716. The examiner can normally be reached on Monday-Fridays; off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey D. Carlson/   Jeffrey D. Carlson
Primary Examiner, Art Unit 3622   Primary Examiner
                                                                Art Unit 3622